

1. The proposed amendment after final rejection filed February 7, 2008 is not compliance with 37 CFR 1.121 and will not be entered.

The proposed amendment attempts to re-instant previously canceled claim 35. This is not permitted by 37 CFR 1.121(c)(5).

The status of claims 1-34 and 49-50 is not shown using an identifier "in a parenthetical expression", as is required by 37 CFR 1.121(c).

The claims are not presented in ascending numerical order in the claim listing, as required by 37 CFR 1.121(c)(1). Note that claims 49 and 50 have to be listed at the end of the claim listing rather than in the first line.

Proposed amendments to claims 36, 41, 43, and 44 are shown using a combination of underlining and single brackets. Assuming these markings are intended to show proposed deletions to the claims, 37 CFR 1.121(c)(2) requires the use of strike-through to show the proposed deletions.

2. Proposed claim 35, even had it been properly submitted as a new claim with a new claim number, it would not have been entered because it raises new issues requiring further search and consideration. Note that the claim is incomplete - words appear to be missing after "compatible". Assuming that the new claim would be identical in scope to proposed claim 35 in the amendment filed January 19, 2007, the new claim would raise the same new issues as outlined in the Advisory action mailed February 13, 2007, section 3.

At proposed claim 43, line 3, "or" should be inserted after the first comma in the line, and at line 4, the comma should be deleted.

3. The examiner maintains his position that the German Patent Application 19926475.9 does not disclose a pharmaceutical which is an antibiotic, analgesic, or virostatic, and does not disclose medicaments for the purpose of treating mammals. Accordingly, claims which recite these limitations would not be entitled under 35 U.S.C. 119(a)-(d) to the benefit of the filing date of the German priority document, and the Kratz et al article (J. Med. Chem., Vol. 43, pages 1253-1256) would remain available as prior art under 35 U.S.C. 102(a) against such claims.

Applicant points to sections of the German priority document (i.e. page 6, line 19; page 8, lines 6-8 and 10-11; and page 21, third line from bottom) which disclose species of antibiotic compounds, species of analgesic compounds, species of virostatic compounds, and a species of mammal. However, disclosure of a few species does not show that Applicant had possession of the entire generic claim at the time of the German priority document. Large generic claims are not “expressly, implicitly or inherently supported” by the disclosure of one or a few species in a foreign priority document. See MPEP 2163(II)(A)(3)(b), second paragraph, and MPEP 2163.05(I) under “Addition of Generic Claim” (Rev. 6, Sept. 2007).

4. The examiner will not enter an amendment after final rejection which seeks to narrow the scope of the claims so that the claims are entitled under 35 U.S.C. 119(a)-(d) to the benefit of the filing date of the German priority document. Such an amendment would raise new issues requiring further consideration and search, because with removal of the Kratz et al article as prior art, search and examination would have to be extended beyond the elected species. See, e.g., MPEP 803.02, paragraph bridging pages 800-5 and 800-6 (Rev. 5, Aug. 2006).

5. Applicant did not make any response to the claim objection set forth in section 2 of the final Office action.

Art Unit: 1654

It should be noted that even if independent claim 36 were to be found allowable, claim 42 would not then be re-joined with the claim. Proposed claim 36 no longer permits the drug to be a diagnostically active substance, and therefore claim 36 is not generic to claim 42.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey E. Russel at telephone number (571) 272-0969. The examiner can normally be reached on Monday-Thursday from 8:00 A.M. to 5:30 P.M. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor Cecilia Tsang can be reached at (571) 272-0562. The fax number for formal communications to be entered into the record is (571) 273-8300; for informal communications such as proposed amendments, the fax number (571) 273-0969 can be used. The telephone number for the Technology Center 1600 receptionist is (571) 272-1600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Jeffrey E. Russel/  
Primary Examiner, Art Unit 1654

JRussel  
March 20, 2008